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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,151	01/28/2004	Yoshihide Goto	7176.3008.001	1957

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EXAMINER

LAMB, BRENDA A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 02/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10766,151

Applicant(s)

Goto

Examiner

LAMB

Group Art Unit

1734

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 1/28/2004
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-10 is/are pending in the application.
- Of the above claim(s) 8-10 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-4 and 6 is/are rejected.
- ☒ Claim(s) 5 and 7 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 12/02/2004 ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other _____

Office Action Summary

Applicant's election of Group I in the reply filed on 12/02/2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation in claim 4 that the apparatus includes an applying dice through which the electric wine is passed is attached to a device holdier is confusing since it is clear from the drawings element 4 is an applying die not a dice or small cube marketed on each side with 1 to 6 dots, usually used in pairs in games.

The disclosure is objected to because of the following informalities: The originally filed specification teaches that element 4 is an applying dice yet it is clear from the drawing that element 4 is clearly an applying die not a dice or small cube marketed on each side with 1 to 6 dots, usually used in pairs in games as discussed above and the applying die is held by a die holder not a dice holder.

Appropriate correction is required.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 3-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller et al.

Miller et al teaches a device for applying coating to a strand comprising: a trough-like container located below the coating to a strand moving in a prescribed moving direction; a coating dropping means which extends above a portion of the travel path of the strand as it travels from spools 11 to spool 24, the coating dropping includes a tank or reservoir 55 which stores the coating, a supplying tube as shown in Figures 1-2 which extends downwardly and includes nozzle 31 at its terminal end and the nozzle is in communication with the tank and through which the coating is supplied and flow-rate adjusting means, valve 42, for adjusting the flow-rate of the coating to be dropped. Miller et al apparatus is capable of coating an electric wire with a varnish since Miller et al teaches every claimed element of the apparatus. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d 1647 (1987). Thus Miller et al teaches every claimed structural element of the apparatus set forth in claim 1. With respect to claim 4, the examiner has interpreted the tip of the container in the moving direction of the strand as being the end portion of the container. Miller et al

shows a die 33 and die holder 36 arranged at the tip or end portion of the container.

With respect to claim 3, the functional recitation that the electric wire travels at speeds within the scope of the claim has not been given patentable weight because it is narrative in form. In order to be given patentable weight, functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 USC 112, 6th paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional recitation. In re Fuller, 1929 C.D. 172; 388 O.G. 279. Miller et al coating dropping means is capable of applying a coating within the scope of the claim. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987).

Claims 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al.

Miller et al is applied for the reasons noted above. Miller et al teaches coating a plurality of strands using a plurality of coating dropping means which correspond to the number of plurality of strands. Miller et al fails to teach a plurality of containers which correspond in number to the number of plurality of strands. However, it would have been obvious to modify the Miller et al apparatus by using a plurality of containers which corresponds in number to the number of plurality of strands since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. (see St. Regis Paper Co. v. Bemis Co., 193 USPQ 8). With respect to claim 6,

Miller et al teaches a curing oven 18 for drying and baking or curing the coating material thereon.

Claims 1, 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hilker in view of Luscher et al and Lylka.

Hilker teaches a device for applying coating to a strand comprising: a coating dropping means which located above the strand so as to correspond to a strand and including a tank or reservoir 54 which stores the coating, a supplying tube as shown in Fig. 1 which extends downwardly and includes nozzle 54 at its terminal end and the nozzle is in communication with the tank and through which the coating is supplied and flow-rate adjusting means, pump 52, for adjusting the flow-rate of the coating to be dropped. Hilker fails to teach a trough-like container located below the strand moving in a prescribed moving direction. However, in apparatus for dropping a material onto a moving strand, both Luscher et al and Rylka show arranging a trough-like container below the moving strand and below coating dropping means to enable one to catch excess coating material. Therefore, it would have been obvious to modify Hilker by providing a trough-like container extending below the coating dropping means and below the moving strand such as shown by both Luscher et al and Rylka for the obvious advantages of catching excess coating from the coating dropping means. Thus claim 1 is obvious over the above-cited combination of references. With respect to claim 3, the functional recitation that the electric wire travels at speeds within the scope of the claim has not been given patentable weight because it is narrative in form. In order to be given patentable weight, functional recitation must be expressed as a "means" for

performing the specified function, as set forth in 35 USC 112, 6th paragraph, and must be supported by recitation Miller in the claim of sufficient structure to warrant the presence of the functional recitation. In re Fuller, 1929 C.D. 172; 388 O.G. 279. In any event, Hilker teaches the strand is driven the coating spool driver 114 (see column 6 line 63 to column 7 line 4) and in Table 1 the strand is driven at different speeds through the coating apparatus indicating the spool driver is a variable speed spool driver and is driven at speeds within scope of the claim. Hilker coating dropping means is capable of applying a coating within the scope of the claim. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). With respect to claim 6, Hilker teaches when a the coating material includes a solvent a curing oven is needed to drive off solvents or dry and bake or cures the coating material thereon.

Claims 5 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art fails to teach or suggest a device for applying coating to a strand comprising: a trough-like container located below the coating to a strand moving in a prescribed moving direction; a coating dropping means which extends above the moving strand, the coating dropping includes a tank which stores the coating, a supplying tube in communication with the tank and through which the coating is supplied and flow-rate adjusting means for adjusting the flow-rate of the coating to be

dropped; wherein container is detachably attached to an attaching plate provided upright on a tray through a holder or wherein the flow-rate adjusting means includes a dropping nozzle attached to the tip of said supply tube; an operating knob provided outside the dropping nozzle, the inner aperture of the nozzle being adapted to be adjustable; a nozzle holder fit in the outer surface of the dropping nozzle, and a guiding member having a u-shape in section, the guiding member being slidably fit in the outside of the nozzle holder in a direction orthogonal to the moving direction of the strand or electric wire.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Lamb whose telephone number is (571) 272-1231. The examiner can normally be reached on Monday and Wednesday thru Friday with alternate Tuesdays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brenda A. Lamb
BRENDA A. LAMB
PRIMARY EXAMINER